

REMARKS

Claims 1-34 are currently pending in the application; which claims 1, 9, 13, 16, and 23 being independent. Applicant respectfully requests entry of this amendment in light of the remarks and amendments presented herein, and earnestly solicits timely allowance of the pending claims.

Claim Rejections – 35 USC § 103

The Examiner rejected claims 1-34 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,629,499 to Flickinger et al. (“Flickinger”) in view of U.S. Pat. No. 5,477,012 to Sekendur (“Sekendur”). Applicant submits the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

Regarding the independent claims, Applicant maintains that neither Sekendur nor Flickinger teach or suggest, at least, “a position coding pattern . . . wherein each position is encoded by directions of displacements between a plurality of marks and grid points,” as recited in claim 1; “a position-coding pattern . . . wherein the position coding pattern utilizes directions of displacements between a plurality of marks and grid points,” as recited in claims 9, 13, and 16; and “wherein the preprinted coding information utilizes the directions of displacements between a plurality of marks and grid points to code different symbol values,” as recited in claim 23.

The Examiner asserts Sekendur teaches the above quoted features. Specifically, the Examiner purports that Sekendur shows in Fig. 2 “various displacement patterns of dots to code different symbols,” and shows in Fig. 5 “an embodiment employing a plurality of grid points.”

Applicants respectfully disagree and submit the Examiner is: i) not properly interpreting the disclosure of Sekendur; and ii) combining separate and distinct embodiments shown by Sekendur without proper motivation to combine these separate and distinct embodiments.

Sekendur discloses several distinct embodiments for designating coordinates on a surface. All of the embodiments encode information by the presence and absence of marks in predetermined locations.

In one embodiment, Sekendur discloses a surface systematically encoded with a plurality of dots. Each dot, as shown in Figure 1, is divided into three concentric circles partitioned into quadrants. The center circle forms a small dot, while the other circles form inner and outer concentric rings. Each quadrant of each ring represents a digit of a 4-digit number and is further divided into four equal slices, the upper right quadrant of the first digit moving clockwise. The outer ring represents the X-coordinate and the inner ring represents the Y-coordinate. As shown in Fig. 2, values are encoded by the presence and absence marks at predetermined locations within each dot. (See col. 4, lines 28-41.) For example, a value of "0" is encoded by having no markings in the dot, and a "blank" value is encoded by marking all of the space within the dot save the center portion. By alternating the presence and absence of markings within each dot, position values may be encoded. Moreover, while the plurality of dots are arranged in a systematic manner, this embodiment does not disclose grid points.

Sekendur discloses other distinct embodiments showing alternative ways of encoding position information, including a barcode system and a system of checkerboard-like squares. (See col. 4, lines 46-48; Figs. 4 and 5, respectively.) Note that in Fig. 5a, one portion of the checkerboard is delineated to the X coordinate while the other portion of the checkerboard is

delineated to the Y coordinate. From Fig. 5a, it can be seen that the encoding is performed by the presence and absence of a sub-square within the checkerboard; whereby different values are determined based upon the location of the sub-square within the square array shown in 5a. A plurality of square arrays comprises the checkerboard as shown in Fig. 5.

In all of these embodiments, Applicant submits that Sekendur is distinguished from the features recited in the claims above, at least in that how the coding is performed on the encoded surface.

In the rejection, the Examiner appears to be combining these distinct embodiments to establish the rejection, and does so without providing any motivation for such a combination. Applicant submits that because these are separate and distinct embodiments, which are disclosed by Sekendur in the alternative (see col. 4, lines 45-50), the Examiner must provide motivation for the combination of these alternative embodiments in order to properly reject them under §103(a), even though they are disclosed in the same reference.

Moreover, Applicant submits that one of ordinary skill in the art would not be motivated to combine these separate and distinct embodiments for determining position information, as this would unnecessarily complicate decoding the pattern.

Accordingly, Applicant respectfully requests the Examiner to withdraw the §103 rejection of claims 1, 9, 13, 16, and 23. Claims 2-8, 28, 29, and 32 depend from claim 1 and are at least allowable by virtue of their dependency from allowable claim 1. Claims 10-12 depend from claim 9 and are allowable at least by virtue of their dependency from allowable claim 9. Claims 14 and 15 depend from claim 13 and are at least allowable by virtue of their dependency from allowable claim 13. Claims 17-22 and 33 depend from claim 16 and are allowable at least

by virtue of their dependency from allowable claim 16. Claims 24-27 and 34 depend from claim 23 and are allowable at least by virtue of their dependency from allowable claim 23.

The Examiner rejected claims 30-31 under 35 U.S.C. §103(a) as being unpatentable over Flickinger in view of Sekendur, and further in view of U.S. Pat. No. 6,327,395 to Hecht ("Hecht"). Applicant respectfully traverses the rejection as the Examiner has failed to provide adequate motivation to establish a *prima facie* case of obviousness.

Regarding claims 30 and 31, the Examiner asserts that it would have been obvious and desirable to have used the position coding teachings of Sekendur and Hecht to improve Flickinger by replacing the position sensing grid with a position coded medium. The Examiner further asserted that this would allow position to be sensed without the use of a position sensing clipboard. (See Office Action; page 13, paragraph no 5.)

Applicant submits that the motivation provided by the Examiner to modify the combined teachings of Sekendur and Flickinger by Hecht is insufficient. The teachings of Sekendur alone would satisfy the Examiner's purported motivation, as Sekendur alone teaches a position encoded medium.

Hecht teaches a self-clocking glyph code pattern which is composed of elongated slash-like marks. The glyph pattern communicates digital information by encoding binary "1's" and "0's" by varying the tilt of each slash mark by +45 deg. and -45 deg. as shown in Fig. 1. That is, each slash mark, (which is 4x4 or 7x7 pixels) directly corresponds to a single binary digit. A maximal bit sequence is encoded by a plurality of glyphs placed on parallel lines of the glyph code pattern which propagate in a predetermined direction. (See col. 5, lines 23-65.)

Sekendur's encoding works in a very different manner, wherein each mark represents a plurality of bits depending not upon its orientation, but the presence or absence of coloration in predetermined areas within each mark.

Because Sekendur's and Hecht's encoding schemes work in such vastly different ways, one of ordinary skill in the art would not be motivated to combine their teachings. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 30 and 31.

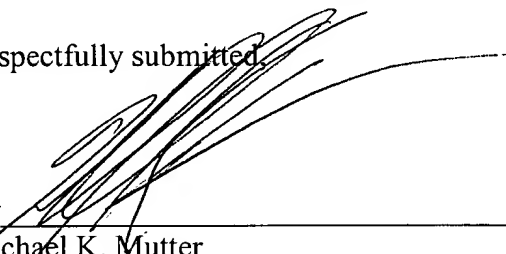
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Date: March 22, 2006

Respectfully submitted,


By _____
Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Rd
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant